

REMARKS

The Office Action mailed on March 31, 2003, has been reviewed and the comments of the Patent and Trademark Office have been considered. Prior to this paper, claims 1-15 were pending in the present application. By this paper, Applicants have added claims 16-27 and cancelled no claims. Therefore, claims 1-27 are now pending in the present application.

Applicants respectfully submit that the present application is in condition for allowance for the reasons that follow.

Consideration of the IDS Filed on November 30, 2001

Applicants respectfully request that the Patent Office consider the Information Disclosure Statement filed on November 30, 2001. Applicants further request that a copy of the initialed PTO Form 1449 be returned to Applicants' representatives.

Rejections Under 35 U.S.C. § 102

Claims 1-2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese laid-open applications 9-291337 and JP 63-65020. In response, Applicants have made the above amendments to claim 1 and respectfully submit that the above claims are allowable for the reasons that follow.

Applicants rely on MPEP § 2131, entitled "Anticipation – Application of 35 U.S.C. 102(a), (b), and (e)," which states that a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." It is respectfully submitted that the cited references do not describe each and every element of amended claim 1.

Claim 1 recites that the steel has a *surface hardness in a range from 91 to 96 HRB*. Claim 1 further recites that this hardness is obtained through warm-forging and normalizing. Neither of these two claim elements is found in the cited references.

A steel according to claim 1 provides steel with a high forgeability, a high hardenability, and a high resistance to high-temperature softening. Such a steel provides free-cutting characteristics and also develops hardenability through control of the grain structure of the steel.

In contrast, neither of the cited references teach either the claimed hardness or the claimed warm-forging and normalizing steps. Both the '337 reference and the '020 reference teach hardnesses values for the alloy examples identified in the Office Action that appear to suggest surface hardnesses well above the claimed hardness range when correlated to the HRB scale. Still further, neither of the abstracts of the cited references teach warm-forging or normalizing. Thus, claim 1, as amended, is allowable in view of Japanese laid-open applications 9-291337 and JP 63-65020.

Claim Rejections Under 35 U.S.C. §103(a)

In the Office Action, Claims 1 and 2 are rejected under 35 U.S.C. §103(a) as being unpatentable over USP 4,115,111 ("Itoh"). Applicants respectfully submit that claim 1, as amended, is allowable in view of Itoh for at least the following reasons.

Applicants rely on MPEP § 2143, which states that: "[t]o establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations." As discussed above, Claim 1 recites that the steel has a *surface hardness in a range from 91 to 96 HRB*, and that this hardness is obtained through warm-forging and normalizing. Neither of these two latter claim elements appear to be taught or suggested by Itoh. Thus, claim 1 is allowable in view of Itoh for at least this reason.

New Claims

As seen above, Applicants have added new claims 16-26 which further differentiate the present invention from the cited references. Applicants submit that these claims belong in Group I. Applicants respectfully submit that these claims are allowable for at least the reason that they depend from claim 1, an allowable claim.

Rejoinder of Some of the Withdrawn Claims

Claims 3-15 stand withdrawn. Applicants note that claims 3-10 depend from claim 1. Applicants respectfully request that the PTO rejoin at least claims 3-10 due to their dependency from claim 1, a claim that is allowable.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Yee is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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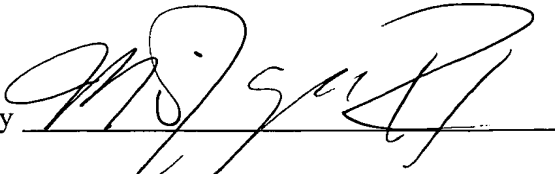


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